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**OFFICE OF PETITIONS**

In re Application of :  
Furtek, et al. :  
Application No. 10/719,409 :  
Filed: November 22, 2003 :  
Attorney Docket No. NVDA/P002849 :

**ON PETITION**

This is in response to the "Renewed Petition under 37 CFR 1.137(b)" filed January 8, 2008. The petition will be treated as a renewed petition under 37 CFR 1.78 (a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed non-provisional applications set forth in the amendment filed January 10, 2007.

The renewed petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification remains unacceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an

amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Applicant should note that the reference required by 35 U.S.C. 120 § and 37 CFR 1.78(a)(2)(i) is the claim for priority to the earlier filed application. Applicant is referred to the Section 201.11 (III) of the Manual of Patent Examining Procedure for an example of an acceptable reference to a prior application.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or an amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required. The undersigned is not requesting a copy of the omitted reference, rather a proper ADS or amendment that makes the benefit claim under 35 U.S.C. § 120 and does not improperly incorporate by reference any prior application that was not incorporated by reference on filing of non-provisional application serial number 10/719,409.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

  
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